

### **REMARKS/ARGUMENTS**

Reconsideration of this application and entry of this Amendment are solicited. Claims 1-4, 6 and 8-9 will be active in the application subsequent to entry of this Amendment.

Attached to this response is an unsigned evidentiary declaration of the senior inventor, Mr. Ogawa. An executed document is expected in the next few weeks and will be submitted when received by the undersigned.

This application was the subject of discussions and interview between Examiner Wong and the undersigned on November 17, 2005. The substance of the interview was recorded by the examiner in the Interview Summary mailed November 23, 2005. The Interview Summary itself and the following comments will serve to include the substance of the interview as required by MPEP §713.04.

It is proposed to amend the claims to direct them to preferred aspects of the disclosure. More specifically, the presence of a sucrose fatty acid ester in the milk beverage, the subject of previous claim 5, and the weight ratio relationship between the sucrose fatty acid ester and the polyglycerol fatty acid ester, as stated previous claim 7, are proposed to be incorporated into claim 1. With this change the dependencies of claims 6 and 8 are adjusted.

Prior to this Amendment the percentage ranges stated in claims 1 and 4 were identical. To differentiate the claims the lower value in claim 4 is amended to 0.025% by weight based upon the description at page 10, line 12. This change does not involve new matter, as will be apparent, and serves to differentiate the two claims.

The amendments made to claims 1 and 4 serve to further clarify the invention and distinguish it from the applied references and to advance examination generally. Entry of this amendment is requested.

In the current Official Action there is a single issue presented – the patentability of claims 1-9 over the disclosures of Bernhardt EP 0236288 in view of Rule, Babayan and Talkington. Applicants have carefully studied the examiner's comments on pages 2 and 3 of the Official Action but disagree with the manner in which the references are applied and the conclusions that the Official Action seeks to draw from these disclosures.

The examiner states that "It would have been obvious to a person of ordinary skill in the art, at the time the invention was made, to manipulate polyglycerol fatty acid esters as taught by

Rule, Babayan, and Talkington et al in the milk product of Bernhardt because the use and manipulation of polyglycerol fatty acid esters in the milk products is conventional in the art."

Even if these combination is possible, the combined product is completely different from applicants' claimed product.

The examiner argues that it is apparent to one skilled in this art to manipulate polyglycerol fatty acid esters in the milk product of Bernhardt. Namely, the product considered by the examiner is a milk product of Bernhardt, the "base" reference, whose polyglycerol fatty acid ester component is replaced by polyglycerol fatty acid ester as taught by Rule, Babayan, and Talkington et al.

The product postulated by the examiner is based on the milk product of Bernhardt. In keeping with the disclosures of the base reference, the proposed product must contain a large amount of the polyglycerol fatty acid esters as taught by Rule, Babayan, and Talkington et al because the main point of Bernhardt, that is, reduction of calories, cannot otherwise be attained (see Bernhardt, page 13, 2<sup>nd</sup> paragraph).

Applicants' main point is this – if the primary reference is to be relied upon as a basis for forming the rejection, one must consider the **entire content** of that document and not merely read selected parts. The main point of the reference is to replace the entire fat content with the polyglycerol fatty acid esters and thereby reduce the total calories in the product. The manner in which the reference is applied and combined with the secondary references, however, appears to be quite different as it is being argued one could use a very small amount of polyglycerol fatty acid esters as the emulsifier. Such position goes directly against the overall teaching of the primary reference itself and thus is not a fair/correct application of the reference as applied against applicants' claims.

This subject was discussed in detail with the examiner during the November 17, 2005 interview and is also acknowledged in the examiner's synopsis of that interview. Counsel specifically requests that the basis for this prior art rejection be reconsidered and withdrawn in view of the problems and consequences of the application of the Bernhardt reference.

During the course of the interview there were discussions concerning possible comparisons between the very small amount of polyglycerol fatty acid ester employed in the present invention as compared to emulsifiers in general or of this type as used in prior procedures

and practice. A comparison between such products in the form of a declaration was also discussed and the examiner indicated that such a comparison in the form of a declaration would be entered even after Final rejection. Following up on those discussions attached is the declaration of Mr. Ogawa (unexecuted) which includes three experiments. The first, Experiment 1, follows the procedures, materials and amounts used in Example 1 of the present application. Experiment 2 differs from the Experiment 1 in that the total concentration of emulsifier was increased from 0.1 to 5.0 weight%. The results were unacceptable. The third experiment used the greater amount of 5.0% total emulsifier concentration but did not include a sucrose fatty acid ester. Again, the results were not acceptable. In his declaration, Mr. Ogawa provides his own observations concerning the results of these tests.

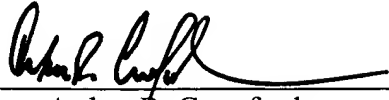
The 5.0% total concentration of emulsifier was selected taking into account various documents, in particular the Talkington patent U.S. 4,960,602, which at column 4, last line to column 5, states "Not more than 50%, preferably not more than 35% and most preferably from about 3 to 15%" of the sucrose fatty acid esters in the total food or beverage composition are employed. Applicants regard a 5% amount as being representative of the lower limits of emulsifiers generally employed in the food and beverage art, at least according to the information of record. It should be noted, for the record, that amounts in a range of 0.14 to about 0.7% are mentioned in Rule U.S. 4,419,378 at column 4, line 48 as regards polyglycerol esters and fatty acids. As discussed above, the use of very small amounts of emulsifier, i.e., 0.01 to 0.1% by weight, would not be apparent to one skilled in the art. Applicants have found that use of significantly greater amounts of emulsifier in the milk beverage product of the present invention lead to unsatisfactory and in some cases unsalable products.

For the above reasons it is respectfully submitted that the claims of this application as above amended define inventive subject matter. Reconsideration, entry of this Amendment, and allowance are solicited. Should the examiner require further information, please contact the undersigned.

OGAWA et al.  
Appl. No: 09/532,024  
December 27, 2005

Respectfully submitted,

**NIXON & VANDERHYE P.C.**

By:   
\_\_\_\_\_  
Arthur R. Crawford  
Reg. No. 25,327

ARC:eaw  
901 North Glebe Road, 11th Floor  
Arlington, VA 22203-1808  
Telephone: (703) 816-4000  
Facsimile: (703) 816-4100